No. 95-926

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1995

MARK I MARKETING CORPORATION and MARK I MARKETING CORPORATION OF AMERICA,

Petitioners,

—v.—

R.R. DONNELLEY & SONS COMPANY,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The judgment below presents the following issues for review:

1. Are factual issues concerning what occurred during the prosecution of a patent application and the implications of a patent's prosecution history to be determined by a jury as issues of fact, or by a court as a matter of law?

PARTIES TO THE PROCEEDING

There are no parties to this case other than those appearing in the caption.

Pursuant to Rule 29.1 of the Rules of this Court, petitioners state that other than the entities named as petitioners in the caption, petitioners have no parent corporations, and neither corporation has sold shares to the public.

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IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995
NO. _____

MARK I MARKETING CORPORATION and MARK I MARKETING CORPORATION OF AMERICA,

Petitioner,

-against-

R. R. DONNELLEY & SONS COMPANY,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

OPINIONS BELOW

This petition seeks review of the opinion issued by the United States Court of Appeals for the Federal Circuit on September 14, 1995 (1a*), which appears at 66 F.3d 285, 36 U.S.P.Q.2d 1095 (Fed. Cir. 1995), which affirmed the order and judgment of the District Court dated

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* Page references incorporating the letter 'a' refer to the appendix.

October 28, 1994 (20a).

STATEMENT OF JURISDICTION

In seeking review of the decision of the United States Court of Appeals for the Federal Circuit, petitioner invokes the certiorari jurisdiction conferred on this Court by 28 U.S.C. § 1254(1).

STATUTES INVOLVED

United States Constitution, Article I, Section 8, Clause 8

The Congress shall have the power...to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

United States Constitution, Amendment VII

In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rule of the common law.

STATEMENT OF CASE

This patent case involves the invention by Wallace Edwards, the president of the petitioner corporations, of a pioneering printing process which permits the simulated effect of full color printing to be obtained using fewer than the four colors generally required by the industry standard process, known as Four Color Process, and which permits printing on substrates of various colors and qualities, whereas the Four Color Process requires a white high quality substrate. The advantages of this process are significant: for example, the advent of this process permitted color advertising in yellow pages telephone directories which had never before been technologically possible.

Mr. Edwards applied for and was granted United States Patent No. 4,554,241 ("'241 patent") for his process, and has used the trademark "Markolor" to describe the process.

The petitioners licensed Markolor to the Reuben H. Donnelley Corporation (not related to the respondent, R.R. Donnelley), the world's largest publisher of yellow pages directories. R.H Donnelley then introduced the Markolor process to the respondent R.R. Donnelley, which is a printing company to be used in printing R.H. Donnelley's yellow pages products.

When it became clear to the petitioners that R.R.

Donnelley was unabashedly using the Markolor process to print color advertising in yellow pages telephone directories, but refusing to pay the petitioners any royalties, the petitioners commenced this patent infringement action.

R.R. Donnelley's defense was to claim that they are not literally infringing the '241 patent. Moreover, they assert, petitioners are barred from claiming that the process being used by R.R. Donnelley is protected under the doctrine of equivalents by virtue of patent prosecution history estoppel. The basis of this latter assertion is that when Mr. Edwards first applied for his patent, his application was rejected due to prior art, and was not accepted until he submitted a new application paring down his patent claims.

R.R. Donnelley moved for summary judgment in the United States District Court for the Northern District of Illinois.[1] Summary judgment was granted to R.R. Donnelley ostensibly on the ground of the District Judge's finding that there was no triable issue of fact as to whether the process being used by R.R. Donnelley was within the prior art. (34a). The decision of the District Court did not turn on the issue of prosecution history estoppel.

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[1] The action was originally commenced in the Southern District of New York, but venue was transferred to the Northern District of Illinois upon R.R. Donnelley's motion.

An appeal was taken, which was heard by the United States Court of Appeals for the Federal Circuit.

The Federal Circuit affirmed the District Court's decision, but on an entirely different ground than that relied upon by the District Court. The focus of the Federal Circuit's decision was the doctrine of prosecution history estoppel, which had not been the focus of the District Court's decision.

In writing its decision turning on prosecution history estoppel, the Federal Circuit delved into, and decided as a matter of law, the factual issues of the prosecution history of the '241 patent, and actually decided these factual matters on the basis of a cold appellate record, including directly conflicting expert affidavits submitted in the context of a summary judgment motion, without any trial ever having been held on those or any other issues in this case. Thus engaging in factual determinations at the appellate level, the Federal Circuit reached the factual decision that the prosecution history of the '241 patent showed that Mr. Edwards had limited the scope of his patent claims to exclude processes such as that which R.R. Donnelley correctly or incorrectly claimed to be using, and affirmed the District Court's decision to grant summary judgment to R.R. Donnelley.

Petitioner now seeks a writ of certiorari to resolve the question of whether the Federal Circuit properly invaded the province of the jury to decide issues of fact

that were not even directly addressed by the District Court, and which were presented to the Federal Circuit only as a matter of legal argument without the benefit of a trial or a fully developed record.

Moreover, even if the Federal Circuit had relied on the same grounds as the District Court—that there was no issue of fact regarding whether R.R. Donnelley was using a prior art—petitioner would seek a writ of certiorari as this, too, would have been error since the District Court's summary judgment decision was made in the face of directly conflicting witness and expert affidavits and the issue of what process was being used and whether it infringed the patent was clearly in dispute.

REASONS FOR GRANTING THE WRIT

A WRIT OF CERTIORARI SHOULD BE GRANTED SO THAT THIS COURT CAN DECIDE WHETHER THE ISSUE OF PROSECUTION HISTORY ESTOPPEL SHOULD PROPERLY BE ADDRESSED TO A JURY, RATHER THAN AN APPELLATE COURT, AND IN ORDER TO MAINTAIN UNIFORMITY IN THE LAW SINCE AT LEAST ONE OTHER WRIT OF CERTIORARI DEALING WITH A SIMILAR ISSUE HAS RECENTLY BEEN GRANTED BY

THIS COURT[2] AND IF NO WRIT IS GRANTED IN THIS CASE THE PETITIONERS COULD BECOME THE VICTIMS OF A LEGAL ANOMALY AND LEAD TO INCONSISTENT RESULTS IN THIS CRITICAL AREA OF PATENT LAW.

The crux of this petition for a writ of certiorari is the question of which issues in a patent case may be decided by the court, and which issues the court must leave to be decided after trial by the jury. In this case, the Federal Circuit decided issues involving the implications of the prosecution history of the '241 patent. Petitioner submits that these were clearly factual issues, *Smithkline Diagnostics, Inc. v. Helena Laboratories Corporation*, 859 F.2d 878, 882 (Fed. Cir. 1988) (holding that interpretation of patent prosecution history is a factual matter) that should not have been resolved by the Federal Circuit since there were questions of fact, but should rather have been left for the jury to resolve after a trial.

The "prosecution history" of a patent refers to the proceedings in the Patent and Trademark Office that led up to the issue of a patent. *Markman v. Westview Instruments*,

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[2] A writ of certiorari has been granted in *Markman v. Westview Instruments, Inc.*, ___ U.S. ___, 116 S.Ct. 40 (1995). A petition for a writ of certiorari has been filed but not yet decided in *Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512 (Fed. Cir. 1995), a case dealing with similar issues.

Inc. 52 F.3d 967, 980 (Fed.Cir. 1995), cert. granted ___ U.S. ___, 116 S.Ct. 40 (1995). Prosecution history estoppel is a doctrine which bars a patentee from asserting a claim to patent rights over a claim which was relinquished during the patent application process. *Loctite Corp. v. Ultraseal, Ltd.*, 781 F.2d 861, 870 (Fed. Cir. 1985). Prosecution history estoppel functions as a check against the doctrine of equivalents, which permits a patentee to maintain a patent infringement claim when another person uses a process or device which is the functional equivalent of the patent. See, *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 70 S.Ct. 854 (1950). Thus, although the doctrine of equivalents can operate to expand a patent beyond its literal verbiage, the prosecution history of a patent, once it is fully determined, can be used to prevent the expansion of a patent's claims into areas that were specifically excluded from the patent claim during the patent application process. *Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512 (Fed. Cir. 1995).

The doctrine of equivalents and the use of prosecution history estoppel to limit the doctrine of equivalents have in the past been viewed as creatures of equity. See, *Loctite*, 781 F.2d at 870 and 871 n. 7. As creatures of equity, these doctrines would be applied purely as matters of law. However, the Federal Circuit, relying on this Court's decision in *Sanitary Refrigerator v. Winters*, 280 U.S. 30, 50 S.Ct. 9 (1929), has very recently

made it clear that the doctrine of equivalents is not a matter of equity and that any decision in a patent case turning on the doctrine of equivalents is to be decided by a jury or the District Court where it is the trier of fact. *Hilton Davis*, 62 F.3d 1520-21.

Clearly, the *Hilton Davis* decision that issues of the doctrine of equivalents are factual issues to be decided by the jury raises a question as to whether issues of prosecution history estoppel, which exists as a check on the doctrine of equivalents, should also be decided by the jury.

The Federal Circuit's decisions prior to *Hilton Davis* do not assist in resolving this issue. Although the Federal Circuit decided in *Smithkline Diagnostics, Inc.* v. *Helana Laboratories Corporation*, a 1988 decision, that the interpretation of a patent prosecution history is a factual matter, the Federal Circuit's 1989 decision in *LaBounty Manufacturing Inc.* v. *United States International Trade Commission*, 867 F.2d 1572 (Fed. Cir. 1989), which was explicitly relied upon by the Federal Circuit in the case now at bar (16a), reached the conclusion that "the application of prosecution history estoppel is a question of law."[3] *Id*, 867 F.2d at 1576.

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[3] It is not entirely clear that when the *LaBounty* court wrote that "application of prosecution history estoppel is a matter of law" it intended to overrule the *Smithkline* court's decision that the determination of "what occurred during the prosecution history" is

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The holding that the court may "look as a matter of law to the prosecution history" was recently repeated in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir 1995), cert. granted ___ U.S. ___, 116 S.Ct. 40 (1995), a case which preceded *Hilton Davis* by four months. Since this Court has granted a writ of certiorari in *Markman* (that appeal is scheduled to be fully briefed by the end of December, 1995), the continuing validity of the Federal Circuit's holding in that case cannot be certain at this time. See, *Id.*, 52 F.3d 999-1026 (Newman, J. dissenting).[4] It is

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an issue of fact. Clearly, determining factually what happened during the prosecution of a patent can be seen as distinct from applying that prosecution history to the interpretation of a patent claim, and thus both holdings could co-exist.

However, in the case at bar, the Federal Circuit cited *LaBounty*—without even mentioning *Smithkline*—and proceeded to interpret and apply the prosecution history of the '241 patent, although no factual determination of what occurred during the prosecution of the '241 patent was ever made by the District Court and the relevant facts were never presented to a jury.

[4] In her dissenting opinion in *Markman*, Judge Newman argues powerfully that the issues patent infringement and prosecution history estoppel should be left to the jury. Directly addressing prosecution history estoppel, Judge Newman wrote:

> The majority refers to the "undisputed" prosecution history, in asserting that there are no factual aspects to this evidence. Indeed, the official government record is fixed. But the significance of the exchanges, compromises and explanations contained in the correspondence between the inventor and the examiner; the inferences to be drawn as to the technology, the invention and the

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unclear why the Federal Circuit's decision in the case at bar, which was handed down over five months after *Markman*, that a patent's prosecution history can be decided as a matter of law by the court relied on *LaBounty* rather than the more recent decision in *Markman*.

Despite the Federal Circuit's decision in *Markman*, uncertainty arises with regard to the question of whether the prosecution history of a patent is to be determined as an issue of law or fact. The *Loctite* decision, which assumed that the doctrine of equivalents and prosecution history estoppel are creatures of equity, was the foundation of the *LaBounty* decision relied on by the Federal Circuit in the case at bar to determine the prosecution history as a matter of law, but the Federal Circuit's decision in *Hilton Davis*, which is based on this Court's venerable decision in *Sanitary Refrigerator*, calls the continued vitality of *LaBounty*, and any other decision holding that the doctrine of equivalents and prosecution history estoppel can be determined by the courts as a matter of law, into question.

> meaning and scope of now-disputed technologic terms or words of art; may depend on this and other evidence. If disputed, their finding is for the trier of fact. The meaning significance, and weight of the content of a documentary record does not become a matter of law simply because the content of the record is not in dispute.

Markman, 52 F.3d at 1004 (Newman, J. dissenting).

Since a petition for a writ if certiorari has been granted in *Markman*, ___ U.S. ___, 116 S.Ct. 40, and according to the Supreme Court Clerk's Office a writ of certiorari has been petitioned for in *Hilton Davis*, and the confusion arising from the interplay of these two decisions directly affects the question of whether the decision below in this case was correctly decided, petitioner submits that a writ of certiorari should be granted in this case as well.

Not to grant a writ of certiorari in this case could lead to an anomalous result if the decision in *Markman* should be reversed and the decision in *Hilton Davis* should be sustained, since that would mean the precedential underpinnings of the Federal Circuit's decision in this case would be undermined while the decision in this case would be left unchanged. Granting a writ of certiorari would permit this Court to make certain that such an inconsistent outcome does not obtain, and also that the petitioner is not made the victim of a legal anomaly, unable to obtain the result that this Court's decision in *Markman* could require.

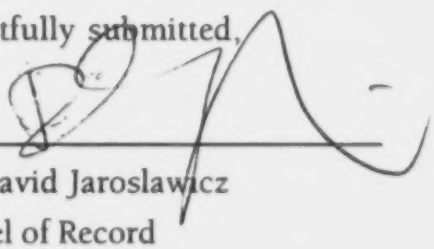
CONCLUSION

For the reasons set forth herein, petitioners respectfully request that this Court grant a writ of certiorari so that this Court can address the issue of whether the determination of issues of fact where there is

a defense of prosecution history estoppel are issues of fact for a jury, and to prevent the possibility of the petitioner becoming the victim of a legal anomaly if the decision underlying the Federal Circuit's decision in this case is overruled.

Dated: December 11, 1995

Respectfully submitted,

By: 

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Opinion of the United States Court of Appeals for the Federal Circuit

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

95-1101

MARK I MARKETING CORPORATION and MARK I MARKETING CORPORATION OF AMERICA,

Plaintiffs-Appellants,

v.

R.R. DONNELLEY & SONS COMPANY,

Defendant-Appellee.

DECIDED: September 14, 1995

Before NIES, MAYER, and LOURIE, Circuit Judges.

LOURIE, Circuit Judge.

Mark I Marketing Corporation and Mark I Marketing Corporation of America (collectively "Mark I") appeal from the order of the United States District Court for the Northern District of Illinois granting summary judgment of noninfringment in favor of R.R. Donnelley &

Sons Company ("Donnelley"). *Mark I Mktg. Corp. V. R.R. Donnelley & Sons Co.*, No. 92 C 8380 (N.D. Ill. Nov. 1, 1994). Because prosecution history estoppel precludes Mark I from asserting infringement under the doctrine of equivalents, we affirm.

BACKGROUND

Color images in magazines, books, and newspapers are conventionally formed by a process that uses four printing plates and the four "process" inks (cyan, magenta, yellow, and black). In this process, four films or "separations" are first made by scanning an original color image with an electronic scanner or by photographing the image through different colored filters.[1] Once the separations are prepared, they are used to make four printing plates, each one corresponding to a process ink color. When used in combination, the printing plates generate a four-color. When used in combination, the printing plates generate a four-color image which, to the

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[1] When a photographic process is used, the filters are of colors complementary to the process ink colors. Thus, three separations are made by separately photographing the original image through red, blue, and green filters; the separations are used to make printing plates that will print cyan, yellow, and magenta inks, respectively. A fourth separation, used to make a printing plate that will print black ink, is made either by photographing the original through a combination of red, blue, and green filters, or by

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naked eye, appears to encompass the entire spectrum of colors and shades.

For certain printing applications, such as the printing of telephone directories, newspapers, and advertising flyers, the conventional four-color separation process is prohibitively expensive due to the need to prepare and use four printing plates. The invention disclosed and claimed is U.S. Patent 4,554,241[2] addresses this problem by providing a process for printing color images on paper using only two printing plates and two "non-process" inks. Wallace Edwards is the inventor of this process and the chairman and chief executive officer of Mark I. Edwards assigned his rights in the invention to Mark I.[3]

The '241 patent discloses a process in which each of two printing plates is created by sequentially making two different filter exposures of an original color image on a separation film. The first printing plate, which prints red ink, is made by sequentially exposing a separation film through green and blue filters. The second plate, which

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photographing the original in black and white.

[2]The '241 patent issued from application Serial No. 712,659, filed March 18, 1985, which was a continuation-in-part of Serial No. 595,815, filed April 2, 1984. The '815 application was itself a continuation-in-part of Serial No. 485,668, filed April 18, 1983.

[3]For simplicity we will refer only to Mark I when discussing the '241 invention and the prosecution history of the '241 patent.

prints another non-process ink such as green, blue, or black ink, is made by sequentially exposing a separation film through red and blue filters. Claim 1 of the patent, which is the focus of this litigation, defines the invention as follows:

> 1. A method of printing on a sheet member a realistic reproduction of a colored original, utilizing a minimum of two different superimposed impressions, each with a different coloring medium, comprising:
>
> (a) providing a colored original,
>
> (b) creating a first printing plate intended to print a non-process red color, by
>
> (1) making a green filter exposure of the original on a first means for recording a first optical image,
>
> (2) making a blue filter exposure of the original on said first means,
>
> steps (1) and (2) being carried out sequentially in any order,
>
> (c) creating a second printing plate intended to print a second color different from that printed by said first plate, by
>
> (3) making a red filter exposure of the original on a second means for recording a second optical image,

(4) making a blue filter exposure of the original on said second means,

steps (3) and (4) being carried out sequentially in any order,

steps (b) and (c) being carried out in any order,

(d) providing a sheet member to receive two superimposed impressions, and

(e) using said first and second printing plates to print said red color and said different color, respectively, as the said superimposed impressions on said sheet member [emphasis added].

The patent specification indicates that either photographic or scanning techniques may be used to carry out the invention:

> Each film is exposed sequentially through the two filters or with the equivalent two lights on [a] conventional scanner.
>
> ....
>
> It is emphasized again that the interposition of actual colored filters between the original and a means for recording an optical image (such as a piece of film) is not the only way to create the appropriate printer. The presently available scanner machines accomplish the same effect

> by illuminating the original with light of a particular color. In the ... claims, reference is made to "making a... filter exposure", etc., and it is to be understood that this wording is intended to embrace those techniques which do not actually require a physical filter to be interposed, but which achieve exactly the same effect as if the filter had been interposed.

Col. 3, 11. 42-44; col. 6, 11. 6-17.

Donnelley is in the business of producing Yellow Pages telephone directories. It prints color images for its directories using a commercially available Crosfield scanner and two non-process inks. The scanner focuses a single beam of white light on a small area (a "pixel") of the colored original. The light reflects back into the scanner where it is split into three separate light beams. The beams are then simultaneously filtered through red, green, and blue filters within the scanner. Next, the scanner senses the intensities of the beams and converts this information into digital values which are stored in memory. The scanner repeats this process for each pixel until the entire image has been scanned. To create separations, the scanner analyzes the stored data to determine the size and density of the various ink dots needed to replicate each pixel's color. It then converts the data into electrical impulses, sends the impulses to light sources (lasers or lamps), and pulses the light sources to expose tiny spots on separation films. Each spot of film is

either exposed only once or is not exposed at all. The resulting separations are used to make printing plates, which in turn are used to print images in Donnelley's telephone directories.

Mark I sued Donnelley alleging infringement of the '241 patent.[4] Donnelley denied the allegation and moved for summary judgment of noninfringement, arguing that it did not literally infringe the patent because it did not use filters sequentially or make sequential exposures of film. In addition, Donnelley argued that its process was known and used before the '241 invention and therefore that the doctrine of equivalents was not applicable. *See Wilson Sporting Goods Co. V. David Geoffrey & Assoc.*, 904 F.2d 677, 684, 14 USPQ2d 1942, 1948 (Fed. Cir. 1990) ("[S]ince prior art always limits what an inventor could have claimed [during prosecution], it limits the range of permissible equivalents of a claim."). Donnelley further argued that prosecution history estoppel precludes Mark I from establishing infringement under the doctrine of equivalents. In response, Mark I essentially conceded that Donnelley did not literally infringe the '241 patent, but argued that genuine issues of material fact precluded summary judgment in Donnelley's favor on Mark I's

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[4] The lawsuit was originally brought in the United States District Court for the Southern District of New York, but was transferred on Donnelley's motion to the United States District Court for the Northern District of Illinois.

theory of infringement under the doctrine of equivalents.

The district court referred Donnelley's motion to a magistrate judge, who issued a Report and Recommendation on June 10, 1994. The magistrate judge determined that prosecution history estoppel precluded Mark I from proving infringement under the doctrine of equivalents and thus recommended that the court grant summary judgment of noninfringement. The district court, deciding the motion independently, granted summary judgment on a different ground. The court determined that Mark I did not refute Donnelley's factual assertion that the accused process was in the prior art and thus that it could not infringe the patent under the doctrine of equivalents. The court found that Mark I, through the affidavit of its expert, had only asserted that the '241 patent was not invalid, even though Donnelley never challenged the patent's validity. Thus, in the court's view Mark I failed to raise a genuine issue of material fact concerning Donnelley's theory of noninfringement. In granting summary judgment, the court found it unnecessary to determine whether prosecution history estoppel precluded Mark I from establishing infringement under the doctrine of equivalents. This appeal followed.

DISCUSSION

Summary judgment is appropriate when there is no genuine issue as to any material fact and the moving

party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1576-77, 12 USPQ2d 1382, 1383 (Fed. Cir. 1989). Thus, summary judgment may be granted when no "reasonable jury could return a verdict for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). In determining whether there is a genuine issue of material fact, the evidence must be viewed in the light most favorable to the party opposing the motion, with doubts resolved in favor of the nonmovant. *Transmatic, Inc. V. Gulton Indus., Inc.*, 53 F.3d 1270, 1274, 35 USPQ2d 1035, 1038 (Fed. Cir. 1995). We review *de novo* a district court's grant of summary judgment. *Conroy v. Reebok Int'l, Ltd.*, 14 F.3d 1570, 1575, 29 USPQ2d 1373, 1377 (Fed. Cir. 1994).

Mark I does not contest the court's determination that Donnelley did not literally infringe the '241 patent. Rather, Mark I asserts that the court erred in holding that Mark I did not refute Donnelley's assertion that the accused process cannot infringe the '241 patent because it is a prior art process. Mark I further argues that the question of prosecution history estoppel raises genuine issues of material fact precluding a grant of summary judgment. Donnelley responds that the court correctly granted summary judgment because Mark I did not dispute Donnelley's contention that it practices the prior art. Alternatively, Donnelley contends that prosecution history estoppel precludes application of the doctrine of

equivalents in this case.

Having thoroughly reviewed the record, we have concluded that the district court's judgment should be affirmed on the ground of prosecution history estoppel. Although the district court did not reach this question, "[b]ecause this issue is purely legal and was fully briefed to the district court, in the interests of economy, this court will decide [the issue] on the merits ...." *Du Pont Merck Pharmaceutical Co. V. Bristol-Myers Squibb Co.*, No. 95-1410, slip op. At 7 (Fed. Cir. Aug. 8, 1995). To determine whether prosecution history estoppel precludes Mark I from establishing infringement under the doctrine of equivalents, we must review the prosecution history of the '241 patent.

A. Prosecution History of the '241 Patent

Mark I filed the "grandparent" application to the '241 patent, Serial No. 485,668, on April 18, 1983. The '668 application broadly claimed a process of simulation colored originals by printing with two different colored inks. Claim 1 of the application required the formation of two separation, but, importantly, it did not require that either separation be made by sequentially interposing two different filters:

> 1. A method of printing on a sheet member a realistic image of an original utilizing two different superimposed impressions with two different inks, comprising:

making a first film and therefrom a first plate adapted to print a first ink having a first hue at all locations corresponding to a first colour predominating in the original,

making a second film and therefrom a second plate adapted to print a second ink having a second hue at locations such that the second ink in relation to the first ink seen against the sheet gives to the eye the impression of a third hue present in the original but not present in either the first or second inks,

coating the plates with their respective inks, and

printing the sheet member with the plates.

In a first Office Action, the U.S. Patent and Trademark Office (PTO) rejected claim 1 under 35 U.S.C. § 102 as being anticipated by a *Du Pont Magazine* article entitled "Multicolor Effects on Two-Color Presses." The article describes two-color printing on colored paper and, in particular, suggests the use of "two printing plates to blend red and blue ink on yellow paper." The PTO also rejected claims 1-5 under 35 U.S.C. §103 as being obvious over the *Du Pont Magazine* article in view of three secondary references. The Office Action was conclusory and did not discuss the cited references or articulate any reasons supporting the rejections.

Mark I, however, did not respond to the Office Action. Instead, it filed a continuation-in-part application. The claims originally filed in that application also required the use of two printing plates and, like the '668 application, did not require that either printing plate be made by sequentially interposing filters. Claim 1 of the '815 application read as follows:

> 1. A method of printing on a sheet member a realistic image of an original, utilizing two different superimposed impressions with two different colouring media, comprising:
>
> creating a first printing plate by the interposition of at least two filters between the original and means for recording a first optical image,
>
> creating a second printing plate by the interposition of at least one filter between the original and means for recording a second optical image,
>
> and using said first and second plates to print the said different impressions with two different colouring media.

On June 8, 1984, before receiving a first Office Action, Mark I amended claim 1 to require that the first, but not the second, printing plate be made by sequentially interposing two different colored filters. Specifically, claim 1 was amended to read as follows:

1. (amended) A method of printing on a sheet member a realistic image of an original, utilizing two different superimposed impressions with two different colouring media, comprising:

creating a first printing plate by the sequential interposition of at least two different colour filters between the original and means for recording a first optical image,

creating a second printing plate by the interposition of at least one filter between the original and means for recording a second optical image,

and using said first and second plates to print the said different impressions with two different colouring media.

Then, in July 1984, Mark I filed a Petition to Make Special pursuant to M.P.E.P. § 708.02.VIII.[5] In the petition, Mark I characterized the claimed invention as

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[5] Section 708.02 VIII of the Manual of Patent Examining Procedure ("M.P.E.P.") permits an accelerated examination of a patent application for which a pre-examination search of the prior art has been conducted. The applicant must, *inter alia*, submit copies of the most pertinent prior art references located by the search and provide "a detailed discussion of the references, which...points out, with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is distinguishable over the references."

(continued next page)

follows:

> The applicant...has discovered an alteration in the film-producing step typically employed in the four-colour separation process which alteration is such as to allow a stunningly realistic reproduction of an original in only two inks....
>
> The alteration...involves, in the case of the use of film, the double exposure of the film using two different filters sequentially [emphasis added].

In addition, quoting language from claim 1, Mark I distinguished the claimed process from several prior art references cited in its accompanying search report on the ground that the references did not suggest " the 'sequential interposition of at least two different colour filters between the original and means for recording a first optical image [emphasis added].'"

Despite Mark I's attempt to distinguish the claimed invention from the prior art based on the claim limitation that the first separation be made by sequentially interposing two filters, the PTO, in a September 18, 1984 Office Action, rejected claims 1 and 4-10 of the '815 application under 35 U.S.C. §103 as being obvious over *The Lithographers Manual*, Vol. I (Waltwin Pub. 1958) in

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M.P.E.P. § 708.02.VIII (6th ed., Jan. 1995).

(continued next page)

view of the *Du Pont Magazine* article. *The Lithographers Manual* suggests making a printing plate using supplemental film exposures with different colored filters. The examiner took the position that it would have been obvious to apply the teachings of *The Lithographers Manual* to any conventional color processing technique, including the two-color process disclosed in the *Du Pont Magazine* article. Dependent claims 2 and 3 were also rejected on similar grounds.

Mark I again did not respond to the Office Action, but instead filed a second continuation-in-part application. That application contained new claims which required, for the first time, that each of the two recited printing plates be formed using two filters, and that both printing plates be made by sequentially making two different filter exposures of the original color image on a film. The application was allowed without comment by the examiner and issued as the '241 patent.

B. Prosecution History Estoppel

Prosecution history estoppel precludes a patentee from obtaining in an infringement suit patent protection for subject matter which it relinquished during prosecution in order to obtain allowance of the claims. *Zenith Lav., Inc. V. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1424, 30 USPQ2d 1285, 1290 (Fed. Cir.), *cert. denied*, 115 S.Ct. 500 (1994). It thus serves as a check on the

applicability of the doctrine of equivalents. The standard for determining whether particular subject matter was relinquished is an objective one that depends on what a competitor reasonably would conclude from the patent's prosecution history. *Id.* The application of prosecution history estoppel is a question of law. *LaBounty Mfg., Inc. v. Uniteds States Int'l Trade Comm'n*, 867 F.2d 1572, 1576, 9 USPQ2d 1995, 1998 (Fed. Cir. 1989).

"The prosecution history must be examined as a whole in determining whether estoppel applies." *Wang Lab., Inc. v. Toshiba Corp.*, 993 F.2d 858, 867, 26 USPQ2d 1767, 1775 (Fed. Cir. 1993). Thus, the relevant prosecution history here includes not only the '659 application but also the parent '815 and grandparent '668 applications. *See Jonsson v. Stanley Works*, 903 F.2d 812, 818, 14 USPQ2d 1863, 1869 (Fed. Cir. 1990) (prosecution history of parent application is relevant to understanding scope of claims issuing in a continuation-in-part application).

The prosecution history of the '241 patent indicates that the grandparent '668 application broadly claimed a process for reproducing color images by printing with two printing plates and two inks. The claims were rejected over prior art that suggested replication a color image using two printing plates and two inks. Instead of responding to the rejection, Mark I filed the '815 continuation-in-part application with new claims. Mark I then narrowed the '815 claims to require that the first

printing plate be made by sequentially interposing filters. Subsequently, in its Petition to Make Special, Mark I argued that the sequential interposition of filters distinguished the claimed invention from the prior art. The '815 application claims were then rejected over a combination of references which, in the PTO's view, suggested using supplemental film exposures in a two-color printing process. Rather than respond to the rejection, Mark I again chose to file a continuation-in-part application with new claims. The claims in the '659 application were even narrower than the '815 claims, and required that both plates be made by sequentially interposing colored filters.

Donnelley argues that the prosecution history of the '241 patent shows that Mark I surrendered claim coverage for a process not involving sequential interposition of colored filters. We agree. The prosecution history demonstrates that Mark I was unsuccessful in obtaining allowance of the claims until they were narrowed to require that both the first and the second printing plates be made by sequentially interposing particular combinations of colored filters. Moreover, during prosecution Mark I asserted that the claims were patentably distinguishable over the prior art based on these process steps. Thus, in our view a competitor reviewing the prosecution history of the '241 patent reasonably would conclude that, in order to procure issuance of the patent, Mark I surrendered claim coverage

to a process not involving sequential interposition of filters.

The fact that the claims of the '659 application were not themselves rejected by the Patent Office or amended by Mark I does not call for a different result. Mark I chose to file continuing applications with successively narrower claims in lieu of otherwise responding to the PTO's rejections, but an estoppel is not avoided by failing to respond to a rejection and instead meeting the substance of the rejection by filing a narrower continuing application. Rather, the prosecution history must be viewed as a whole to determine whether and what subject matter surrendered to procure issuance of the patent. Viewed in its entirety, the prosecution history of the '241 patent clearly shows that Mark I surrendered claim coverage in order to obtain an allowance of the claims.

Mark I argues that, at a minimum, the question of prosecution history estoppel raises genuine issues of material fact precluding a grant of summary judgment. We disagree. The relevant facts here are undisputed; the prosecution history of the '241 patent is a matter of public record. Moreover, the meaning of the prosecution history is clear. A competitor reviewing the '241 patent's prosecution history would not have to go beyond the public record to reasonably conclude that Mark I had relinquished claim coverage for a process not involving sequentially interposing colored filters.

We therefore hold that Mark I is estopped from asserting infringement by any process that does not involve a sequential interposition of colored filters. The accused process indisputably does not involve the sequential interposition of filters; rather, three light beams are simultaneously filtered through red, green, and blue filters within the scanner. Thus, no reasonable fact-finder could find that the accused process infringes the '241 patent; summary judgment of noninfringement was therefore appropriate. *See Brenner v. United States*, 773 F.2d 306, 307, 227 USPQ 159, 160 (Fed. Cir. 1985) (Summary judgment of noninfringement will be upheld on appeal when there is no literal infringement" and a prosecution history estoppel makes clear that no actual infringement under the doctrine of equivalents can be found.").

Because the prosecution history estoppel issue is dispositive, we need not decide whether the district court correctly ruled that Mark I failed to dispute Donnelley's contention that its process is prior art to the '241 patent.

CONCLUSION

The district court's grant of summary judgment of noninfringement in favor of Donnelley is affirmed.

AFFIRMED

Memorandum and Order of the United States District Court for the Northern District of Illinois

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

MARK I MARKETING CORPORATION and MARK I MARKETING CORPORATION OF AMERICA,	)	
Plaintiffs,	)	
	)	NO. 92 C 8380
v.	)	
	)	Hon. George W. Lindberg
R. R. DONNELLEY & SONS COMPANY,	)	
Defendant.	)	

MEMORANDUM AND ORDER

Plaintiffs Mark I Marketing Corporation and Mark I Marketing Corporation of America ("Mark I") brought suit against defendant R.R. Donnelley Company ("Donnelley") alleging that Donnelley has infringed U.S.

Patent No. 4,544,241 (the "'241 patent") originally issued to Wallace Edwards. The proceedings were referred to the assigned Magistrate Judge pursuant to 28 USC § 636 et seq.

Donnelley has moved for summary judgment on the issue of noninfringement as to both literal infringement and infringement under the doctrine of equivalents. The Magistrate Judge considered Donnelley's motion and issued a report and recommendation recommending that Donnelley's motion be granted. Mark I filed objections to the report and recommendation. This court has reviewed de novo the portions of the report and recommendation to which objections have been made. 28 USC § 636(b)(1); FRCP 72(b).

In its motion for summary judgment, Donnelley contends that it does not literally infringe the '241 patent and that, due to the doctrine of prosecution history estoppel and the prior art, Mark I is estopped from asserting the range of equivalents necessary to encompass Donnelley's accused process. Donnelley's motion for summary judgment is granted both with respect to literal infringement and as to noninfringement under the doctrine of equivalents.

I. FACTS

The '241 patent relates to a printing process used

to reproduce photographs and artwork. More specifically, the process described and claimed in the '241 patent consists of a two-color reproduction process used to generate a high quality reproduction of an image on low quality paper such as that used by Donnelley in its "Yellow Pages". The two-color process described in the '241 patent must be distinguished from the standard four-color separation process. The common four-color process cannot be used when the printing is to be made on low quality paper because the four colors tend to run into one another causing a blurry appearance.

Mark I alleges that Donnelley infringes its patented two-color process. Donnelley asserts that its use of a "Crosfield scanner" does not infringe claim one of the '241 patent because the Crosfield scanner does not sequentially expose the original to either different color filters or different color lights in the scanner. The Crosfield scanner operates as follows:

> (a) A single white light shines on a small area of the colored original called a "picture element," or "pixel" for short. That light is reflected into the scanner, where a beam splitter splits the reflected light into three beams which are filtered (simultaneously, not sequentially) through red, green, and blue filters, respectively. The scanner then measures the intensity of the resulting red, green, and blue beams and that information is converted into

electrical voltages. Those voltages are further converted (again, simultaneously, not sequentially) into digital values (numbers); i.e., the red, green, and blue color information is "digitized." That information is then stored in memory and processed as described below. The scanner repeats this process for each pixel until the completed original has been scanned.

(b) On the output side, the separation film is exposed only once; i.e., the film is not double exposed, much less sequentially double exposed as the patent requires. Briefly, the three respective digital values for the red, green, and blue information for a pixel are analyzed together and in relation to one another (again simultaneously, not sequentially) using complicated algorithms derived by the scanner manufacturer which calculate the size and density of the different colored dots of ink which must be laid down in order to simulate the color in the original. Of course, the size and density of those dots depend on the precise colors and types of inks to be used in the final printing stage (and on other factors, such as the color of the paper to be printed on). Therefore, the Crosfield scanner has certain "color correction" functions which allow the scanner operator to adjust for different inks or

paper. These functions use conversion, or "look up," tables to replace the digitized red, green, and blue color information with four new digital values which represent the amount of each of the printing inks which must be used to reproduce the shade and hue of the original pixel. This adjusted digitized information is then used to generate electrical impulses which are sent to lamps (or lasers) and which tell those lamps (or lasers) where to expose tiny spots on the separation negatives to create the required number, size and density of dots on each of the four separations. Each tiny spot on each film falls under the exposing light once and only once and is either fully exposed or not exposed at all. Printing plates are then created from the separations.

The '241 patent is a continuation-in part of serial number 595,815 filed April 2, 1984, since abandoned, which in turn was a continuation-in-part of abandoned application serial number 485,688 filed April 18, 1983. The file history of the '241 patent illustrates that claim one of the '688 application[6] was rejected as anticipated by a DuPont Magazine article and claims 1-5 were rejected as being obvious and unpatentable over the DuPont article in view of other cited references.

In the face of this rejection, the applicant chose to abandon the '688 application and file the '815 continuation-

in-part application. Before the examiner reviewed the '815 application the applicant voluntarily amended new claim one to include the "sequential" limitation at issue in Donnelley's motion for summary judgment. Claim one of the '815 application, as amended, reads as follows:

> 1. A method of printing on a sheet member a realistic image of an original, utilizing two different superimposed impressions with two different colouring media, comprising:
>
> creating a first printing plate by the sequential interposition of at least two different colour filters between the original and means for recording a first optical image,
>
> creating a second printing plate by the interposition of at least one filter between the original and means for recording a second optical image,
>
> and using said first and second plates to print the said different impressions with two different colouring media.

Subsequent to the voluntary amendment, but still prior to the examiner acting upon the '815 application, the applicant filed a renewed petition to make special wherein the applicant argued that the "invention" embodied in the '815 application was patentable over five prior art references discussed in the petition. In its arguments, the applicant stated that each of the five references did not

create a first printing plate by the "sequential interposition of at least two different colour filters between the original and means for recording a first optical image."

The examiner rejected the claims in the '815 patent citing both obviousness in view of the DuPont article and an additional reference and failure to provide an enabling disclosure.[7]

Following rejection of the '815 application, the applicant again filed a continuation-in-part application rather than amending the rejected claims. This continuation-in-part application issued without comment as the '241 patent. Claim one of the '241 patent, the independent claim at issue in these proceedings, reads as follows:

> 1. A method of printing on a sheet member a realistic reproduction of a colored original, utilizing a minimum of two different superimposed impressions, each with a different coloring medium, comprising:
>
> (a) providing a colored original,
>
> (b) creating a first printing plate intended to print a non-process red color, by
>
> (1) making a green filter exposure of the

---

[7] The examiner also noted that the prior art discussed in the renewed petition to make special had been considered.

original on a first means for recording a first optical image,

(2) making a blue filter exposure of the original on said first means,

steps (1) and (2) being carried out sequentially in any order,

(c) creating a second printing plate intended to print a second color different from that printed by said first plate, by

(3) making a red filter exposure of the original on a second means for recording a second optical image,

(4) making a blue filter exposure of the original on said second means,

steps (3) and (4) being carried out sequentially in any order, and

(steps (b) and (c) being carried out in any order),

(d) providing a sheet member to receive two superimposed impressions, and

(e) using said first and second printing plates to print said red color and said different color, respectively, as the said superimposed impressions on said sheet member.

In its motion for summary judgment, Donnelley

contends that the process used to print their Yellow Pages directories does not literally infringe claim one of the '241 patent due to the requirement that the film exposures be made "sequentially". Additionally, Donnelley asserts that, as a result of the applicant's arguments contained in the renewed petition to make special, the doctrine of prosecution history estoppel prohibits Mark I from asserting a range of equivalents sufficient to encompass Donnelley's process. Finally, Donnelley contends that the two color process that it uses falls within the prior art thereby preventing Mark I from asserting infringement under the doctrine of equivalents.

Summary judgment is appropriate when "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." FRCP 56(c). The moving party bears the burden of demonstrating the absence of genuine issues of material fact. *Conroy v Reebok Intl. Ltd.*, 14 F.3d 1570, 1575 (Fed Cir 1994). The moving party, however, need not produce evidence showing the absence of a genuine issue of material fact but rather may discharge its burden by showing the district court that there is an absence of evidence to support the non-moving party's case. *Id.*

> [W]here the nonmoving party will bear the burden of proof at trial on a dispositive issue, a summary judgment motion may properly be

> made in reliance solely on the 'pleadings, depositions, answers to interrogatories, and admissions on file.' Such a motion, whether or not accompanied by affidavits, will be 'made and supported as provided in this rule,' and Rule 56(e) therefore requires the nonmoving party to go beyond the pleadings and by her own affidavits, or by the 'depositions, answers to interrogatories, and admissions on file,' designate 'specific facts showing that there is a genuine issue for trial.

Celotex Corp. v *Catrett*, 106 S.Ct. 2548, 2553 (1986). The issue of patent infringement will be addressed under this standard.

II. CLAIM CONSTRUCTION

The determination of infringement is a two-step process: first, the court interprets the claim to determine its scope and meaning; second, the court determines whether the accused device is within the scope of the properly construed claim. *Dolly Inc.* v *Spalding & Evenflo Co.. Inc.*, 16 F.3d 394, 397 (Fed Cir 1994). Claim construction is a question of law for the court to determine based upon a review of the specification, prosecution history, other claims in the patent and, if necessary, extrinsic evidence such as expert testimony. *Texas Instruments Inc.* v *U.S. Int'l Trade Comm'n*, 988 F.2d

1165, 1171 (Fed Cir 1993).

Claim one requires that each recording means be exposed through two filters and that such exposures occur "sequentially in any order". Mark I suggests that the phrase "sequentially in any order" means "that the exposure is not through filters which are stacked one on top of the other."[8] In support of this interpretation Mark I submits the second affidavit of Mr. Southworth, its printing expert, wherein the affiant states:

> There is no emphasis, discussion or statement regarding the words 'sequential' or 'sequential interposition' in the Voluntary Amendment. To me, the insertion of the word 'sequential' makes it clear that the filters are not to be stacked one on top of the other (aligned along a common axis), as that would be inoperative.[9] Application S.N. 595,815 at page 4, lines 34-36 states, 'The filters are used sequentially, rather than together at the same time.' To me, this

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[8]Mark I neither made this argument nor submitted the supporting affidavit of Mr. Southworth to the Magistrate Judge. However, the court has elected to consider both the argument and the affidavit in deciding all issues addressed herein. 28 USC §636(b)(1), FRCP 72(b).

[9]In passing, the court notes that it is rare indeed that a patentee would include a limitation simply to exclude an inoperative embodiment as suggested in the second sentence of the quotation from Mr. Southworth's affidavit.

means that the filters are not to be stacked one on top of the other.

The definition of "sequentially" urged by Mark I is much more narrow than the ordinary meaning of the term. According to Webster's New World Dictionary, "sequence" means "[t]he following of one thing after another in chronological, causal, or logical order." Webster's New World Dictionary 1224 (3d ed. 1988). This definition does not suggest a "stacking" as suggested by Mark I. Nor is a "stacking" clearly required by the prosecution history or prior art before the court. While it is true that a patentee is free to be his own lexicographer, the ordinary meaning of a term is to be used unless a contradictory meaning is clearly set forth in the patent. *Hoganas AB v Dresser Industries. Inc.*, 9 F.3d 948, 951 (Fed Cir 1993) (giving a term in the claim its plain meaning because "[i]f [the patentee], who was responsible for drafting and prosecuting the patent, intended something different, it could have prevented this result through clearer drafting.") The '241 patent contains no such clear statement of the meaning of the term "sequentially." Rather, statements in the patent such as "[e]ach film is exposed sequentially through the two filters or with the equivalent two lights on the conventional scanner" support the court's use of the ordinary meaning of the term "sequentially".

Mark I further contends that the proper interpretation of the claim language requires the court to

resolve underlying issues of fact thereby preventing summary judgment. Claims are construed from the vantage point of one skilled in the art which can lead to the necessity to resolve factual issues. However, when the patent fails to put one skilled in the art on notice that the term has a definition other than its ordinary meaning, no factual issue is presented. Hoganas AB, 9 F.3d at 951. As a result, the term "sequential" as used in the patent has its ordinary meaning.

III. LITERAL INFRINGEMENT

After interpreting the claim, the court determines whether the accused device is within the scope of the construed claim, that is, whether the accused device or process includes every limitation or an equivalent of each limitation. *Dolly*, 16 F.3d 394. The Magistrate Judge did not consider literal infringement of claim one of the '241 patent evidently because he was under the impression that Mark I had conceded the issue.

> Plaintiffs submit that, while Donnelley does not literally infringe the claim, it does practice a process that is equivalent to the claim and, therefore, must be considered to be infringing.

However, as previously noted, in its briefs in opposition to the Magistrate Judge's recommended disposition, Mark I argues that Donnelley does literally infringe the '241

patent because the term "sequential" is properly interpreted as meaning that "the exposure is not through filters which are stacked one on top of the other." Based on the court's construction of the term "sequential", Donnelley is entitled to summary judgment on the issue of literal infringement. It is not disputed that the Crosfield scanner used by Donnelley exposes the separation film only once, "[e]ach tiny spot on each film falls under the exposing light once and only once and is either fully exposed or not exposed at all", whereas the claim requires double exposures made sequentially. Mr. Southworth stated as much in his first affidavit, "Donnelley (and Flying Color Graphics) do exactly every step called for by claim one of the Edwards patent -- except the use of the filters may not be sequential." (Emphasis added)

IV. DOCTRINE OF EQUIVALENTS

A process or device which does not literally infringe a patent claim may still infringe the claim under the doctrine of equivalents if the accused process appropriates the essence of the patented invention. *Hughes Aircraft Co. v United States*, 717 F.2d 1351 (Fed Cir 1983). Infringement under the doctrine of equivalents exists if the accused process performs substantially the same function in substantially the same way to obtain the same result as is set forth in the claim. *Graver Tank & Mfg. Co. v Linde Air Products*, 339 US 605 (1950). However, the doctrine of

equivalents cannot be used to ignore claim limitations. Dolly, 16 F.3d at 397-99. Each element set forth in the claim or its equivalent must be present in the accused device or process. *Id.* The doctrine of equivalents is limited in its application to the extent that it cannot be used to encompass (1) subject matter which the patentee relinquished during prosecution of the patent, the doctrine of prosecution history estoppel; or (2) subject matter which was present in the prior art. *Haynes Intern., Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1579 (Fed Cir 1993).

Donnelley contends in its motion for summary judgment that both limitations prevent claim one of the '241 patent from encompassing, under the doctrine of equivalents, the process used by Donnelley. The court need not address the issue of prosecution history estoppel because Mark I has failed to raise a genuine issue of material fact as to whether Donnelley's process is within the prior art and therefore beyond the reach of the doctrine of equivalents.

The doctrine of equivalents "may not be used to extend a patent holder's right to exclude beyond what could lawfully have been obtained in an original application." *We Care, Inc. V. Ultra-Mark Int'l Corp.*, 930 F.2d 1567, 1570 (Fed Cir 1991). When presented with Donnelley's argument, Mark I, rather than address the prior art with respect to the scope of equivalents being asserted, urged that the cited art did not invalidate claim one of the '241 patent. As a result, Mark I failed to dispute

the factual assertions actually made by Donnelley, i.e., that Donnelley's process was the same as those processes described by the prior art. There exists a fundamental difference between consideration of prior art when determining validity and consideration of prior art when determining infringement under the doctrine of equivalents. This difference was set forth in Donnelley's memorandum in support of its motion for summary judgment, the Magistrate Judge's Report and Recommendation and Donnelley's response to Mark I's objections. As state in *Wilson Sporting Goods v. David Geoffrey & Assoc.*, 904 F.2d 677, 685 (Fed Cir 1990), a case cited by both Donnelley and the Magistrate Judge:

> [I]t is important to remember that the burden is on Wilson [the patentee] to prove that the range of equivalents which it seeks would not ensnare the prior art Uniroyal ball. Leaving this burden on Wilson does not, of course, in any way undermine the presumed validity of Wilson's actual patent claims. In the present situation, Wilson's claims will remain valid whether or not Wilson persuades us that it is entitled to the range of equivalents sought here.

Mark I has failed to establish that a genuine issue of material fact exists as to whether the process used by Donnelley is within the prior art. Therefore, Donnelley is entitled to summary judgment on the issue of infringement under the doctrine of equivalents.

ORDERED: The objections of plaintiffs, Mark I Marketing Corporation and Mark I Marketing Corporation of America, to the Magistrate Judge's Report and Recommendation are overruled. Defendant R.R. Donnelley & Sons' motion for summary judgment is granted. Judgment in favor of defendant, R.R. Donnelley & Sons, and against plaintiffs, Mark I Marketing Corporation and Mark I Marketing Corporation of America, will be set forth on a separate document and entered in the civil docket. FRCP 58, 79(a).

ENTER:

S/George W. Lindberg
GEORGE W. LINDBERG
District Judge

DATED: OCT 28 1994

Supreme Court, U.S.
FILED
JAN 11 1996
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No. 95-926

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

MARK I MARKETING CORPORATION and
MARK I MARKETING CORPORATION OF AMERICA,
Petitioners,

v.

R.R. DONNELLEY & SONS COMPANY,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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RESPONDENT'S BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether summary judgment was properly entered in favor of respondent based on the doctrine of "prosecution history estoppel" where the courts below concluded that the relevant facts concerning the prosecution history of petitioners' patent were undisputed and that the meaning of the prosecution history was clear.

LIST OF PARTIES AND AFFILIATES

The caption of the case in this Court contains the names of all parties. The respondent has no parent companies or non-wholly owned subsidiaries.

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RESPONDENT'S BRIEF IN OPPOSITION

Respondent R.R. Donnelley & Sons Co. ("Donnelley") respectfully submits this brief in opposition to the petition for a writ of certiorari filed by Mark I Marketing Corp. and Mark I Marketing Corp. of America (together, "Mark I"). Because the decision below was a correct and straightforward application of settled principles governing the entry of summary judgment and the doctrine of "prosecution history estoppel" to the specific facts of this case, this Court should deny the petition. Despite petitioners' transparent attempt to make it appear that this

case should be held pending disposition of *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir.) (*in banc*), *cert. granted*, 116 S. Ct. 40 (1995), the petition here presents no question at issue in *Markman* and, indeed, the court of appeals did not even mention *Markman* in its decision. The decision below was correct regardless of the ultimate disposition of *Markman*, and the petition therefore should be denied.

STATUTORY AND CONSTITUTIONAL PROVISIONS INVOLVED

Petitioners assert that this case involves two provisions of the United States Constitution: U.S. CONST., art. I, § 8, cl. 8, which provides Congress with authority to grant patents, and U.S. CONST., amend. VII, which guarantees a right to a jury trial in civil suits at law. (Petn. 2.) This case actually involves only the doctrine of "prosecution history estoppel" and FED. R. CIV. P. 56.

REASONS FOR DENYING THE PETITION

In the decision below, the Federal Circuit unanimously held that respondent was entitled to summary judgment because the "undisputed" facts established that, in the course of prosecuting the applications that resulted in the patent at issue in this case, Mark I had narrowed its patent claim in a manner that excluded Donnelley's accused process from the patent's scope. (Petn. App. 18a-19a.) This decision was nothing more than a straightforward and correct application of prosecution history estoppel, a doctrine which prevents a patentee from "obtain[ing], through litigation, coverage of subject matter relinquished during prosecution" of the patent application. *Zenith Laboratories, Inc.* v. *Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1424 (Fed. Cir.), *cert. denied*, 115 S. Ct. 500 (1994). The question whether prosecution history estoppel in general should be determined as a matter of law or of fact was not relevant below because the Federal Circuit held that this case presented "no genuine issue of

material fact" under that doctrine. (Petn. App. 18a.) The Federal Circuit's application of prosecution history estoppel to the specific, undisputed facts of Mark I's patent prosecution does not create a conflict with any decision of this Court, the Federal Circuit, or any other court of appeals, and it does not raise any significant issue of law warranting this Court's attention.

Petitioners, recognizing that the decision below presents no issue worthy of this Court's review, attempt to recast the court of appeals' narrow, fact-specific application of prosecution history estoppel into a sweeping pronouncement on the "question of which issues in a patent case may be decided by the court, and which issues the court must leave to be decided after trial by the jury." (Petn. 7.) The obvious purpose of this recharacterization is to persuade this Court to hold this case on its docket pending its decision in *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir.) (*in banc*), *cert. granted*, 116 S. Ct. 40 (1995), a case which involves the issue whether the construction of patent claims is a question of law or fact. But this case presents no question under consideration in *Markman*. *Markman* involves only claim construction and not prosecution history estoppel; this case involves only prosecution history estoppel and not claim construction (because the meaning of the patent claim at issue was undisputed before the court of appeals). That is why the Federal Circuit's decision below did not discuss or even mention that court's earlier *in banc* decision in *Markman* or the other claim construction cases cited in the petition; the issues raised in *Markman* were and are irrelevant to the resolution of this case.

1. In its unanimous decision, the Federal Circuit simply applied the settled doctrine of prosecution history estoppel to the undisputed facts concerning Mark I's prosecution of its patent before the Patent and Trademark Office ("PTO"). The doctrine of prosecution history estoppel prevents a patentee from recapturing, through

litigation under the doctrine of equivalents,[1] a breadth of coverage for the patent's claims that the patentee surrendered while prosecuting the patent application. *See, e.g., Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126, 136-37 (1942); *Zenith*, 19 F.3d at 1421; *Haynes Int'l, Inc.* v. *Jessop Steel Co.*, 8 F.3d 1573, 1577-78 (Fed. Cir. 1993). Under the doctrine of prosecution history estoppel, the patentee's amendments to previously rejected patent claims, representations to the PTO, and arguments made to the PTO in order to obtain the patent—all of which are a matter of public record at the PTO (*Standard Oil Co.* v. *American Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985))—can estop a patentee from claiming in subsequent infringement litigation a broader scope for its patent than that which it led the PTO to believe it was seeking during the prosecution of its patent application. *See Haynes*, 8 F.3d at 1579; *Texas Instruments* v. *ITC*, 988 F.2d 1165, 1173-75 (Fed. Cir. 1993).

The court of appeals correctly stated and applied this doctrine in the decision below. Before the magistrate judge,[2] the district court, and the court of appeals, Don-

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[1] The doctrine of equivalents permits a patentee to maintain an infringement claim even where the accused product or process does not literally infringe the patent, if that product or process "performs substantially the same function in substantially the same way to achieve substantially the same result." *See Graver Tank & Mfg. Co.* v. *Linde Air Prods. Co.*, 339 U.S. 605, 608 (1951); *London* v. *Carson Pirie Scott & Co.*, 946 F.2d 1534, 1537 (Fed. Cir. 1991).

[2] The petition incorrectly states that the court of appeals decided the issue "on the basis of a cold appellate record" because "the doctrine of prosecution history estoppel . . . had not been the focus of the District Court's decision." (Petn. 5.) What the petition fails to disclose, however, is that Donnelley's motion for summary judgment had been referred in the first instance to a magistrate judge, and the magistrate judge, in a detailed report and recommendation, recommended that summary judgment be granted to Donnelley based on the doctrine of prosecution history estoppel. (*See* Opposition Appendix ("Opp. App.") 10a-13a.) The district

nelley argued that Mark I had surrendered during the prosecution of its patent application any claim to a two-color printing process that does not involve the use of (1) two printing plates, (2) each of which is prepared using the "sequential" interposition of two different-colored filters between the original image and the film. The court of appeals examined the undisputed prosecution history of the Mark I patent and agreed with Donnelley that it was entitled to judgment as a matter of law:

> The prosecution history demonstrates that Mark I was unsuccessful in obtaining allowance of the claims until they were narrowed to require that both the first and second printing plates be made by sequentially interposing particular combinations of colored filters. Moreover, during prosecution Mark I asserted that the claims were patentably distinguishable over the prior art based on these process steps.

(Petn. App. 17a.) Because it was undisputed that Donnelley's "accused process does not involve the sequential interposition of filters" but rather involves a "simultaneous" use of three filters in an electronic scanner, the court of appeals affirmed the district court's grant of summary judgment to Donnelley. (*Id.* at 19a.)

Petitioners' contention (Petn. 9-12) that this Court should grant the petition to resolve the purportedly unsettled question whether prosecution history estoppel is a question of law or fact (a) misrepresents the state of the law concerning prosecution history estoppel; (b) mischaracterizes the basis of the decision below; and (c) ignores the adequate and independent grounds for summary judgment in Donnelley's favor, grounds which make this case an extremely poor vehicle to decide the question stated in

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court did not "focus" on prosecution history estoppel only because it granted summary judgment on the alternative and sufficient basis that Mark I had presented no evidence to rebut Donnelley's showing that its accused process was already a part of the prior art at the time that Mark I obtained its patent. (Petn. App. 19a.)

the petition, even if that question were in fact presented in this case.

a. First, contrary to petitioners' assertion, there is no "uncertainty" or "confusion" in the Federal Circuit as to whether the application of prosecution history estoppel is a matter of law or fact. (*See* Petn. 11-12.) The Federal Circuit for years has consistently held that "the application of prosecution history estoppel is a question of law." *LaBounty Mfg. Co.* v. *ITC*, 867 F.2d 1572, 1576 (Fed. Cir. 1989).[3] No decision of the Federal Circuit or any other court has ever suggested that the application of prosecution history estoppel is not a matter of law, and petitioners do not and cannot cite any case so holding.

Indeed, the only two cases petitioners cite as evidence of the supposed "uncertainty" or "confusion" in the Federal Circuit—*Smithkline Diagnostics, Inc.* v. *Helena Laboratories Corp.*, 859 F.2d 878 (Fed. Cir. 1988), and *Hilton Davis Chemical Co.* v. *Warner-Jenkinson Co.*, 62 F.3d 1512 (Fed. Cir. 1995) (*in banc*), *cert. pending*, No. 95-728—did not even involve prosecution history estoppel, much less hold that it is a question of fact for the jury. *Smithkline* involved only the question whether claim interpretation is a matter of law or fact, and mentioned the prosecution history of the patent only as a potential aid to claim interpretation, not as a source of estoppel against the patentee. *See* 859 F.2d at 882, 884. Petitioners' professed confusion as to why *LaBounty* and the decision below did not "even mention[] *Smithkline*" (Petn. 9-11 & n.3) is thus easily resolved: *Smithkline* had nothing to do with prosecution history estoppel.

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[3] *Accord Southwall Technologies* v. *Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995); *Genentech, Inc.* v. *Wellcome Foundation*, 29 F.3d 1555, 1567 n.35 (Fed. Cir. 1994); *Hoganas AB* v. *Dresser Indus., Inc.*, 9 F.3d 948, 952 (Fed. Cir. 1993); *Texas Instruments*, 988 F.2d at 1173; *Loctite Corp.* v. *Ultraseal, Ltd.*, 781 F.2d 861, 870 (Fed. Cir. 1985).

Nor does *Hilton Davis* create any uncertainty as to whether application of prosecution history estoppel is a matter of law or fact. *Hilton Davis* involved only the question whether the determination of "equivalence" between an accused product or process and a patented invention under the doctrine of equivalents is a question of law or fact. *See* 62 F.3d at 1515, 1522. The Federal Circuit's holding, consistent with numerous prior decisions of this Court (*see, e.g., id.* at 1520-21, citing *Graver Tank*, 339 U.S. at 609-10) and the Federal Circuit, was that infringement under the doctrine of equivalents, like literal infringement, must be decided by the jury where genuine issues of material fact exist. *Hilton Davis*, 62 F.3d at 1522. *Hilton Davis* says nothing about "whether issues of prosecution history estoppel . . . should also be decided by the jury." (Petn. 9.) Nor does *Hilton Davis* "call the continued vitality of *LaBounty*, and any other decision holding that . . . prosecution history estoppel can be determined by the courts as a matter of law, into question." (*Id.* at 11.) To the contrary, infringement under the doctrine of equivalents has always been viewed as a question of fact (*see Hilton Davis*, 62 F.3d at 1520-28), just as the application of prosecution history estoppel has always been viewed as a question of law (*see supra* at 6 n.3). No conflict existed between these principles before *Hilton Davis*, and none exists now.

Put simply, there is *no* intracircuit "uncertainty" or "confusion" on the question Mark I raises in its petition. Every decision of the Federal Circuit to address the question has held that application of the doctrine of prosecution history estoppel is a matter of law, and the cases Mark I cites as evidence of "uncertainty" or "confusion" did not address that question in the least.

b. Second, petitioners' suggestion that the decision below depended upon a holding that application of prosecution history estoppel is a question of law mischaracterizes that decision. The Federal Circuit correctly stated in an

introductory paragraph the principle that "[t]he application of prosecution history estoppel is a question of law" (Petn. App. 16a), but this principle ultimately was unnecessary to the court's decision, because the Federal Circuit held that petitioners had not raised *any* "genuine issue[] of material fact precluding a grant of summary judgment" (*id.* at 18a). The court applied ordinary summary judgment principles, viewing the evidence in the light most favorable to Mark I and resolving any doubts in Mark I's favor (*id.* at 8a-9a), and concluded that "the relevant facts here are undisputed" (*id.* at 18a), and thus "no reasonable factfinder could find that the accused process infringes the [Mark I] patent" (*id.* at 19a). Even now, although petitioners repeatedly assert that the Federal Circuit improperly resolved "factual issues" or "issues of fact" that should have gone to a jury (*e.g.*, Petn. 5, 6, 7, 9, 10 n.3, 12), they do not even attempt to identify any specific disputed factual issue that the courts below improperly decided.

In short, even if, as petitioners contend, application of prosecution history estoppel can present questions of fact, the court of appeals properly affirmed the entry of summary judgment in Donnelley's favor in this particular case. Where, as here, the evidence reveals the existence of no genuine issues of material fact, summary judgment is appropriate regardless of whether the underlying question is generally a matter of law for the court or fact for the jury. *See Celotex Corp.* v. *Catrett*, 477 U.S. 317, 325 (1986); *Anderson* v. *Liberty Lobby, Inc.*, 477 U.S. 242, 254-55 (1986).[4] Therefore, even if uncertainty actually existed as to whether application of prosecution

[4] That the decision below represents a routine application of FED. R. CIV. P. 56 to undisputed facts rather than a pronouncement on the Seventh Amendment rights of patent litigants is underscored by the fact that Judge Mayer, who vigorously opposed the decision in *Markman* to commit claim construction exclusively to the court (*see* 52 F.3d at 989-98), joined the opinion in this case without comment.

history estoppel in general is a matter of law or fact, that issue is not presented and could not properly be resolved in this case.

c. Finally, even if there were "uncertainty" or "confusion" as to whether application of prosecution history estoppel is an issue of law or fact (and there is not), and even if the decision below squarely posed that question for this Court's review (and it does not), this case would be an extremely poor vehicle by which to decide that question, because an independent and adequate ground exists to affirm the Federal Circuit's judgment: the district court's separate holding that Donnelley's accused process was found in the "prior art" well before Mark I's patent issued. It has long been settled that a patentee may not assert infringement by expanding the scope of its patent's claims so as to "read on the prior art," that is, to encompass products or processes already in existence at the time the patent issued. *See, e.g., We Care, Inc.* v. *Ultra-Mark Int'l, Inc.*, 930 F.2d 1567, 1571 (Fed. Cir. 1991). In this case, as Mark I concedes (Petn. 4, 6), the district court granted summary judgment to Donnelley on the independent ground that Mark I had failed to come forward with any evidence to refute Donnelley's showing that its accused process was already part of the prior art at the time of Mark I's patent (Petn. App. 34a-35a). The Federal Circuit did not reach this alternative ground because it held that Donnelley was entitled to summary judgment under the prosecution history estoppel doctrine. (*Id.* at 19a.) Accordingly, because this Court could affirm the Federal Circuit's judgment on the independent, alternative ground employed by the district court, this case is not an appropriate one in which to attempt to resolve the question stated in Mark I's petition.[5]

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[5] In apparent recognition of the fact that the district court's holding provides an adequate and independent ground to affirm the judgment, petitioners briefly suggest that they also seek to have this Court grant certiorari to determine whether the district court

2. Nor is there any reason to hold this case pending this Court's decision in *Markman*. Although petitioners strive mightily to force this case into the *Markman* mold, the simple fact is that *Markman* and this case address entirely different issues, and thus this case would be unaffected by any decision this Court could reach in *Markman* later this Term.

Markman involves the question whether "the interpretation or construction of patent claims, which define the scope of the patentee's rights under the patent, is a matter of law exclusively for the Court." 52 F.3d at 970. *See also id.* at 976 ("It is the first step, commonly known as claim construction or interpretation, that is at issue in this appeal."). In answering that question affirmatively, the *in banc* Federal Circuit surveyed its own previous decisions on the construction of patent claims (*id.* at 976-77), this Court's decisions on the construction of patent claims (*id.* at 977-78), and various policy reasons for construing patent claims as a matter of law and not fact (*id.* at 978-79). Based on this survey, the Federal Circuit held "that in a case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim." *Id.* at 979. *Markman* did not address prosecution history estoppel at all. Indeed, the *Markman* court discussed the

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erred by granting summary judgment in the face of "directly conflicting witness and expert affidavits" on the prior art issue. (Petn. 6.) As an initial matter, determining whether the district court applied the settled summary judgment standards of FED. R. CIV. P. 56 to the facts of this case is plainly not an issue worthy of this Court's review. Moreover, the district court's decision was plainly correct. Even after the magistrate judge expressly warned petitioners that they had failed to present any evidence on the prior art issue and thus risked summary judgment (Opp. App. 14a-15a), petitioners still failed to offer any evidence that Donnelley's process was not found in the prior art (Petn. App. 34a-35a). Even now, although the petition again alludes generally to the existence of factual disputes, it does not identify any submissions creating a material factual dispute that would preclude summary judgment with respect to this alternative ground. (Petn. 6.)

prosecution history of the patent there at issue only as an aid "to understand the language in the claims" (*id.* at 980), not as a source of estoppel under the prosecution history estoppel doctrine.

The Federal Circuit's decision in this case, on the other hand, turned solely on prosecution history estoppel. (*See* Petn. App. 10a-19a.) The court held that Mark I was estopped by its statements and actions in the PTO from claiming, under the doctrine of equivalents, that its patent covered processes, like Donnelley's, that did not involve the "sequential" use of two filters. (*Id.* at 19a.) The court below did not address any issue of claim construction, because the only claim construction issue presented at any point in the proceedings below—whether the claim term "sequentially" meant (as Donnelley contended) "one after the other" or (as Mark I contended) "not stacked one on top of the other" (*id.* at 29a-31a)—had already been resolved in Donnelley's favor by the district court (*id.* at 30a-31a) and was not appealed by petitioners to the Federal Circuit (*see id.* at 9a). In short, the prosecution history estoppel question resolved by the Federal Circuit below was entirely different than the claim construction question raised in *Markman*. That is why the Federal Circuit did not even mention in its decision below its earlier *in banc* decision in *Markman* or any of the other claim construction cases surveyed in the *Markman* opinion.

Indeed, the courts have always drawn a distinction between the use of prosecution history as an aid to claim construction and the use of prosecution history to estop a patentee, a distinction that Mark I's petition tries hard to blur. In *Loctite Corp.* v. *Ultraseal, Ltd.*, 781 F.2d 861 (Fed. Cir. 1985), the Federal Circuit explained that using prosecution history to interpret claims and using it to estop a patentee from claiming broad coverage for its patent under the doctrine of equivalents are two different things:

> Prosecution history estoppel is relevant here to the statements made by [the patentee] during the '012 patent prosecution to circumvent prior art . . . . *Though the same statements were used to interpret the claims in view of the prosecution history, the two doctrines are to be distinguished. Interpreting claims in view of the prosecution history applies as a preliminary step in determining literal infringement. Prosecution history estoppel applies as a limitation to the doctrine of equivalents after the claims have been properly interpreted and no literal infringement has been found.*

Id. at 870 (emphasis added). *See also id.* at 871 (although courts can look to the prosecution history to interpret claims, "[i]n the prosecution history estoppel context, different considerations apply").[6]

In sum, there is no basis to hold this case pending this Court's decision in *Markman*. The Federal Circuit's decision here did not involve any question of claim construction, but instead involved only the separate question of prosecution history estoppel. Therefore, contrary to petitioners' assertions, even if this Court were to reverse the decision in *Markman* and hold that claim construction is a question of fact that must be decided by a jury, it would create no "legal anomaly" (Petn. 12) for petitioners. Whether claim construction is held to be a question of fact or a question of law, the result in this case would still be the same—petitioners would be estopped as a matter of law from claiming that Donnelley's process infringed their patent because they relinquished any such claim during the prosecution of that patent.

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[6] *Accord Read Corp.* v. *Portec, Inc.*, 970 F.2d 816, 823-25 (Fed. Cir. 1992); *Biodex* v. *Loredan Biomedical, Inc.*, 946 F.2d 850, 862-63 (Fed. Cir. 1991); 4 D. CHISUM, *Patents* § 18.05[4] (1995).

CONCLUSION

For the reasons stated above, respondent respectfully requests that the Court deny the petition for certiorari.

Respectfully submitted,

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January 11, 1996

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APPENDIX

APPENDIX

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

No. 92 C 8380

MARK I MARKETING CORPORATION, and MARK I MARKETING CORPORATION OF AMERICA,
Plaintiffs,

vs.

R.R. DONNELLY & SONS COMPANY,
Defendant.

HONORABLE GEORGE W. LINDBERG,
JUDGE UNITED STATES DISTRICT COURT

HONORABLE JUDGE:

REPORT AND RECOMMENDATION
of Magistrate Judge Edward A. Bobrick

Before the court is the motion of defendant R.R. Donnelly & Sons Company ("Donnelly") for summary judgment on Count I of the complaint of plaintiffs Mark I Marketing Corporation ("MIC") and Mark I Marketing Corporation of America ("MICA").

In Count I of their complaint, plaintiffs allege that defendant has infringed U.S. Patent No. 4,554,241 originally issued to Wallace Edwards ("Edwards Patent"). The Edwards patent describes a process of printing lifelike color pictures using just two different inks. According to plaintiffs' complaint, this process is well-suited to the

thin paper stock which defendant uses to print its Yellow Pages telephone directory, and defendant makes use of the process despite plaintiffs' objections. Defendant has moved for summary judgment, arguing that there is no genuine issue of fact as to its noninfringement of the Edwards patent because it "does not do what the words of the patent claims describe." (Donnelly's Memorandum in Support, at 1). We examine the record as it presently stands to determine whether summary judgment is appropriate in this matter.

I. BACKGROUND

The parties have provided us with some history of the printing processes used to render multi-color reproductions of photographs or artwork. Generally, the subject photograph or artwork is photographed through four different filters, each drawing out a separate hue from the subject: yellow, magenta, cyan, or black. From these four separate images, four separate printing plates are made, each one corresponding to a color. Transparent inks of those colors—called process inks—are then used on the corresponding plates. Next, the colors are printed in turn, one on top of another, to achieve a result that exhibits a wide array of shading and blending of hues. The process is generally called "four color process" printing. The "four color process" is difficult to apply in the Yellow Pages industry, however, because of expense and limitations owing to the paper stock used. For example, Yellow Page stock is of relatively low quality and does not receive the four overlapping inks very well. The Edwards patent represents a solution to this problem: the plaintiffs call it a "breakthrough;" the defendant calls it an "alternative."

A. *Facts*

We draw the material facts of this case from the parties' Local Rule 12 submissions. The inventor of the patent-in-suit, Wallace Edwards, filed his first patent application before the U.S. Patent and Trademark Office

("Patent Office") as Serial No. 485,668 ("No. '688") in April 18, 1983. No. '668 described a method that called for:

> making a first film and plate to print a first ink having a hue corresponding to the colour predominating in the original,
>
> making a second film and plate to print a second ink having a hue that in relation to the first ink against the sheet gives the impression of a third hue, not present in either the first or second inks,
>
> coating the plate with their respective inks and printing the sheet.

(Donnelly's Rule 12(m) Statement "12(m) St."), ¶ 11). The Patent Office rejected Edwards' claim as anticipated by, and obvious in light of, a 1978 *DuPont Magazine* article on two-color printing on colored paper. While Edwards did not respond to the rejection, he filed a continuation-in-part, Serial No. 595,815, on April 2, 1984, in which he claimed:

> creating a first printing plate by the interposition of at least two filters between the original and the means for recording a first image,
>
> creating a second printing plate by the interposition of at least one filter between the original and means for recording a second image, and
>
> using the plates to print different impressions with two different coloring media.

(*Id.* at ¶ 13). Edwards then voluntarily amended his claim on June 8, 1984, as follows:

> creating a first printing plate by the *sequential* interposition of at least two *different colour* filters between the original and means for recording a first optical image,
>
> creating a second printing plate by the interposition of at least one filter between the original and means for recording a second optical image,

> and using said first and second plates to print the said different impressions with two different colouring media.

(*Id.* at ¶ 14 (emphasis in original)). On July 9, 1984, Edwards filed a "Renewed Petition to Make Special Under 708 (VIII) of M.P.E.P.," acknowledging prior art which simulated standard, four-color process printing with less than a four-color separation process. Edwards distinguished his process on the basis of sequential double exposure of film:

> "The applicant . . . has discovered an alteration in the film-producing step typically employed in the four-colour separation process which alteration is such as to allow a stunningly realistic reproduction of an original in only two inks . . .
>
> The alteration mentioned above involves, in the case of the use of film, the double exposure of the film using two different filters sequentially."

(*Id.* at ¶ 15). Edwards' Renewed Petition to Make Special then distinguished five separate prior art patients—Milligan, Laber I, Larber II, Larber III, and Larber IV—on the basis of the Edwards patent's use of the "sequential interposition of at least two different color filters between the original and means for recording a first optical image." (*Id.*, Ex. H, at 28-30). Thus, Edwards distinguished each one on the basis that it did not disclose creating a first printing plate by the *sequential interposition* of a least two different color filters between the original and the film: a means for recording a first optical image. The Patent Office rejected the claims of Serial No. 595,815 ("No. '815") in part as being "obvious" in light of the *DuPont Magazine* article described above and *The Lithographers Manual.* Edwards did not respond to the Examiner's rejection of Serial No. 595,815, but instead filed a second continuation-in-part, Serial No. 712,659, ("No. '659") on March 19, 1985. That application was allowed without comment by the Examiner. (*Id.*, Ex. H,

pp. 38-42). Claim 1, which is the focus of this litigation, reads as follows:

1. A method of printing on a sheet member a realistic reproduction of a colored original, utilizing a minimum of two different superimposed impressions, each with a different coloring medium, comprising:

a) providing a colored original,

b) creating a first printing plate intended to print a nonprocess red color, by

1) making a green filter exposure of the original on a first means for recording a first optical image,

2) making a blue filter exposure of the original on said first means,

steps 1) and 2) being carried out sequentially on any order,

c) creating a second printing plate intended to print a second color different from that printed by said first plate, by

3) making a red filter exposure of the original on a second means for recording a second optical image,

4) making a blue filter exposure of the original on said second means,

steps 3) and 4) being carried out sequentially in any order,

steps b) and c) being carried out in any order,

d) providing a sheet member to receive two superimposed impressions, and

e) using said first and second printing plates to print said red color and said different color,

> respectively, as the said superimposed impressions on said sheet member.

(12(m) St., Ex. H).

According to Donnelly, it has used many different processes to print color images. Donnelly submits, however, that these processes have never involved:

> creating a printing plate intended to print a non-process red color by making a sequential green filter exposure and a blue filter exposure of the original image on a film (or other means), and
>
> creating a printing plate by making a sequential red filter exposure and blue filter exposure of the original image on a film (or other means).

(*Id.*, at ¶ 18). Plaintiffs disagree with Donnelly's position. Specifically, plaintiffs argue the Donnelly utilized the Edwards process for color printing on yellow paper. Specifically, plaintiffs charge that Donnelly makes a plate to print non-process red ink by making a film with a green and a blue filter, and a plate to print non-process blue ink by making a film with both red and blue filters. (Plaintiffs' Rule 12(m) Response ("Pl. Resp.") at ¶ 18). Plaintiffs contend that this is the same process as that described in claim 1, paragraphs b, c, d, and e, of the Edwards patent. (*Id.*; *see supra* at 5a-6a). Plaintiffs' contentions are based on the Affidavit of Miles Southworth, a printing expert and consultant.

Donnelly states that a firm called Flying Color Graphics prepares the separations Donnelly uses in its Yellow Pages printing on a commercially available Crosfield scanner. In the process, according to Donnelly, the film is neither double-exposed nor sequentially double-exposed. The Crosfield scanner operates as follows:

> (a) A single white light shines on a small area of the colored original called a "picture element," or "pixel" for short. That light is reflected into

the scanner, where a beam splitter splits the reflected light into three beams which are filtered (simultaneously, not sequentially) through red, green, and blue filters, respectively. The scanner then measures the intensity of the resulting red, green, and blue beams and that information is converted into electrical voltages. Those voltages are further converted (again, simultaneously, not sequentially) into digital values (numbers); *i.e.*, the red, green, and blue color information is "digitized." That information is then stored in memory and processed as described below. The scanner repeats this process for each pixel until the completed original has been scanned. (12(m) St., Ex. D, ¶ 12).

(b) On the output side, the separation film is exposed only once; *i.e., the film is not double exposed, much less sequentially double exposed as the patent requires.* Briefly, the three respective digital values for the red, green, and blue information for a pixel are analyzed together and in relation to one another (again simultaneously, not sequentially) using complicated algorithms derived by the scanner manufacturer which calculate the size and density of the different colored dots of ink which must be laid down in order to simulate the color in the original. Of course, the size and density of those dots depend on the precise colors and types of inks to be used in the final printing stage (and on other factors, such as the color of the paper to be printed on). Therefore, the Crosfield scanner has certain "color correction" functions which allow the scanner operator to adjust for different inks or paper. These functions use conversion, or "look up," tables to replace the digitized red, green, and blue color information with four new digital values which

> represent the amount of each of the printing inks which must be used to reproduce the shade and hue of the original pixel. This adjusted digitized information is then used to generate electrical impulses which are sent to lamps (or lasers) and which tell those lamps (or lasers) where to expose tiny spots on the separation negatives to create the required number, size and density of dots on each of the four separations. Each tiny spot on each film falls under the exposing light once and only once and is either fully exposed or not exposed at all. Printing plates are then created from the separations. (12(m) St., Ex. D., ¶ 13).

Plaintiffs argue that the Crosfield scanner, although commercially available, may be adjusted to utilize the Edwards patent process. (Pl. Resp. ¶ 21). Further, plaintiffs submit that the claims of the Edwards patent do not require the film be double-exposed; any double-exposure or sequential interposition language refers to the use of photographic equipment as opposed to a scanner. (Pl. Resp., ¶ 21).

B. *Parties' Positions*

According to Donnelly, an essential element of the Edwards patent is the sequential interposition of at least two different color filters between the original and the means for recording the first optical image. Donnelly submits that its process—involving the Crosfield scanner—does not practice this claim. Plaintiffs submit that, while Donnelly does not literally infringe the claim, it does practice a process that is equivalent to the claim and, therefore, must be considered to be infringing.

Donnelly contends that two rules of law prevent the application of plaintiffs' doctrine of equivalents argument to the instant case. First, Donnelly submits that "prosecution history estoppel" precludes plaintiffs from arguing that the sequential interposition of filters is unnecessary

to the Edwards patent. Second, and similarly, Donnelly also contends that what plaintiffs cannot do what they seek to do through the doctrine of equivalents: expound the Edwards patent to "read as prior art." Accordingly, Donnelly argues that, as a matter of law, it is entitled to summary judgment on Count I of plaintiffs' complaint.

II. ANALYSIS

Summary judgment is appropriate when "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The moving party bears the burden of demonstrating the absence of genuine issues of material fact. *Conroy v. Reebok Intern., Ltd.*, 14 F.3d, 1570, 1575 (Fed. Cir. 1994). The moving party, however, need not produce evidence showing the absence of a genuine issue of material fact but rather may discharge its burden by showing the district court that there is an absence of evidence to support the nonmoving party's case. *Id.* Here, Donnelly seeks to show there is an absence of evidence to support plaintiffs' charges of infringement.

The determination of infringement is a two-step process: first, the court interprets the claim to determine its meaning and scope; second, the court determines whether the accused device or process is within the scope of the property construed claim. *Dolly, Inc. v. Spalding & Evenflo Companies, Inc.*, 16 F.3d 394, 397 (Fed. Cir. 1994). It is the plaintiff's burden to demonstrate infringement by establishing that the accused device or process include every limitation of the claim or an equivalent of each limitation. *Id.* Here, plaintiffs argue that Donnelly's process is the equivalent of the Edwards patent process: specifically, that Donnelly's process infringes every step of the Edwards patent claim 1, except that the filter ex-

posures for the film are not made sequentially. (Pl. Resp., Ex. A, ¶ 8).

Under the doctrine of equivalents, an accused device or process may infringe a claim if it performs substantially the same overall result as the claimed invention. *Id.* The element substituted in the accused device for the element set forth in the claim must not be such as would substantially change the way in which the function of the claimed invention is performed. *Id.* The parties would appear to agree that a determination as to whether Donnelly has infringed the Edwards patent under the doctrine of equivalents is inappropriate in the context of this summary judgment motion. Donnelly, however, submits that the application of the doctrine of equivalents is barred by two legal doctrines: "prosecution history estoppel" and "reading on the prior art."

A. *Prosecution History Estoppel*

Prosecution history estoppel prevents a patentee from obtaining, through litigation, coverage of subject matter relinquished during prosecution of the patent. *Haynes Intern., Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1577 (Fed. Cir. 1993). The legal standard for determining what subject matter has been relinquished is objective: what was a competitor reasonably entitled to conclude, from the prosecution history of the patent, that the patent applicant gave up in order to procure the issuance of the patent. *Id.* Donnelly argues that the history of prosecution of the Edwards patent precludes plaintiffs from abandoning the requirement of a *sequential* exposure of film in order to record the image. It would follow, from this premise, that Donnelly does not infringe the process because its use of the Crosfield scanner does not involve a sequential exposure of film. The issue, then, is whether the sequential exposure of film is a required element of th Edwards patent.

Plaintiffs advance several arguments against the application of prosecution history estoppel in this case. First,

and foremost, plaintiffs submit "that only arguments advanced, and necessary, to overcome cited prior art" estop the recapture of subject matter relinquished by the amendment. Plaintiffs offer no citation in support of this proposition and, indeed, it would appear that the law is otherwise. In *Texas Instruments, Inc. v. U.S. Intern. Trade Com'n*, 988 F.2d 1165 (7th Cir. 1993), the court indicated that prosecution history estoppel was, as a general rule, based on the amendment of a claim to avoid a prior art reference, but also indicated, further, that "[u]nmistakeable assertions . . . in support of patentability, whether or not required to secure the allowance of the claim, also may operate to preclude a patentee from asserting equivalency between a limitation of the claim and a substituted structure or process stop." 988 F.2d at 1174. More specifically, there is a broad range of activities taken before the patent office that can give rise to prosecution history estoppel, including: statements contained in a disclosure document in the PTO file; representations made during the presentation of the patent application; remarks made during the prosecution of a claim not in suit; statements made after the examiner indicated the claims were allowable. *Haynes Intern., Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1579 (Fed. Cir. 1993). (footnotes omitted). An estoppel can arise even though the claim, which is the basis for the assertion of the doctrine of equivalents, was not amended during prosecution. *Id.* Plaintiffs' premise for rejection of Donnelly's motion, then, is based on far too narrow a reading of the law. Thus, plaintiffs' argument that prosecution history estoppel is inapplicable to this case because the language at issue was voluntarily added is of no moment to resultion of this issue.

From this faultily narrow premise, plaintiffs proceed to argue that the language at issue, referring to the sequential interposition of at least two different filters, is irrelevant to any prior art or prosecution history. It would appear that plaintiffs' argument in this respect is based on the

fact that Edwards abandoned No. '815, in which he used the language at issue to distinguish prior art, and that the second continuation-in-part, No. '659, was allowed without comment. As noted above, however, even if the subject claim goes unamended during prosecution, prosecution history estoppel can still apply.[1] Here, it is beyond dispute that the Edwards patent claims, at 1(b), the "making a green filter exposure of the original on a first means for recording a first optical image" and "making a blue filter exposure of the original on said first means," requiring the sequential interposition of filters. In connection with Edwards' preceding petition, which admittedly was abandoned, this sequential interposition was the single most distinguishing factor with respect to prior art. We feel that, in light of the holdings in *Haynes* and *Texas Instruments*, the emphasis Edwards placed on this claim during the proceedings before the PTO ultimately leading to the Edwards patent preclude the application of the doctrine of equivalents in this matter. While this may not amount to "a classic example of prosecution history estoppel—an amendment in response to a prior art rejection," *Haynes*, 8 F.3d at 1579, it is sufficient given the present case law interpreting the scope of the doctrine. It cer-

[1] In *Texas Instruments*, for example, the court focused on the interaction between the inventors and the PTO during the prosecution of a "grandparent" application. There, the patent-in-suit stemmed back fourteen years to an original application. That application was superseded by a "patent" application and a continuation which matured into the patent-in-suit. 988 F.2d at 1173-74. Despite the intervention of fourteen years and two applications, the court found that the patentee surrendered certain claims in order to distinguish prior art during the prosecution of the grandparent application that could not be reclaimed. 988 F.2d at 1175. This was, simply put, part of the record made in the PTO upon which other players in the marketplace were entitled to rely. *Id.* Here, similar players must be entitled to rely on the emphasis Edwards placed on "sequential interposition" in prosecuting the predecessor application to the Edwards patent. That emphasis, like the statements in *Texas Instruments*, is part of the record made in the PTO.

tainly indicates, contrary to plaintiffs' assertions, that the language at issue is not "irrelevant" to the Edwards patent.

Before dispensing with discussion of the issues of prosecution history estoppel and the doctrine of equivalents, we return briefly to the applicable legal standard. Plaintiffs' insinuations notwithstanding, the standard is, as already noted, an *objective* one. *Supra,* at 10a (*citing Haynes,* 8 F.3d at 1578). The test is drawn from the standpoint of a competitor's reasonable conclusions given the entire prosecution history of the patent. *Id.* Here, in connection with the petition that preceded the Edwards patent, there was what could only be characterized as emphasis placed on the sequential interposition language. This language then became central to claim 1 of the Edwards patent. Review of this history would certainly allow a competitor to reasonably conclude that the language at issue was a necessary requirement of the Edwards patent. Prosecution history estoppel, then, precludes plaintiffs from asserting the doctrine of equivalents in this case. Accordingly, we cannot find a material issue of fact precludes the entry of summary judgment in Donnelly's favor based on prosecution history estoppel.

B. *Reading on the Prior Art*

Because we dispose of this matter under the prosecution history estoppel doctrine, we need not resolve the issue of whether plaintiffs improperly seek to expand the claims of the Edwards patent to "read on prior art." For the sake of thoroughness, however, we will briefly address Donnelly's argument in this regard. Essentially, Donnelly argues that it has used the accused method for printing for many years; that plaintiffs are accusing Donnelly of infringement for engaging in a widely-used practice that is well-known in prior art. In short, according to Donnelly, plaintiffs are attempting to expand the scope of the Edwards patent, through the doctrine of equivalents, to "read on prior art."

It is true, as Donnelly suggests, that prior art restricts the range of the doctrine of equivalents. *We Care, Inc. v. Ultra-Mark Intern. Corp.*, 930 F.2d 1567, 1570 (Fed. Cir. 1991). Since prior art limits what an inventor *could have* claimed, it also limits the range of permissible equivalents of a claim. *Id.* (emphasis added). Thus, a determination on this issue must include consideration of whether the range of equivalents asserted by the patentee encroaches on prior art. *Id.* at 1570. This involves consideration of what prior art would have anticipated, what it would have made obvious at the time the patentee filed the original application. *Id.* Obviousness and anticipation both involve factual issues that are ordinarily not amendable to summary judgment. *Id.*; *Chester v. Miller*, 906 F.2d 1574, 1576 (Fed. Cir. 1990). In this case, especially since we dispose of this matter under another theory, we are hesitant to render a decision on Donnelly's "prior art" theory due to the factual issues involved. We note, however, that it would appear that plaintiffs have failed to adequately address this theory in their submissions on this matter.

As we interpret it, Donnelly's argument is based on the fact that the process it uses—involving a scanner and two non-process inks—had been used for some time in the printing industry. (Rule 12(m), ¶¶ 21-26). Thus, according to Donnelly, plaintiffs' arguments that this process infringes the Edwards patent necessarily involve an expanion of the Edwards patent's claims to include long-known processes that were part of the prior art. Rather than address this argument, plaintiff submit that Donnelly is attempting to have the Edwards patent declared invalid. (Memorandum in Opposition, at 25-26). Because Donnelly does not make such an argument anywhere in its submissions, plaintiffs have left themselves open to an entry of summary judgment on this issue in Donnelly's favor for their failure to adequately respond to Donnelly's motion. Nevertheless, we feel that plaintiffs' misapprehension of the issue has left the record in-

sufficiently developed on the question of "reading on the prior art." Accordingly, we choose not to rule on this issue at this time.

III. CONCLUSION

Donnelly has submitted two legal arguments in favor of summary judgment. We decline to rule on the second—that plaintiffs seek to expand the claims of the Edwards patent to "read on the prior art" through the doctrine of equivalents—due to the inadequate development of the record relating to that issue. Donnelly's first argument—that "prosecution history estoppel" precludes plaintiffs' use of the doctrine of equivalents in this case—does not involve any factual issues and is adequate to support summary judgment in this matter. In short, plaintiffs' stance that the "sequential interposition of filters"—the double exposure of film—is not a necessary element of Edwards patent is unsupported by the record before the PTO. Based on that record, a competitor could reasonably conclude that "sequential interposition" was indeed a required element. Accordingly, prosecution history estoppel precludes plaintiffs from arguing that Donnelly's process—which admittedly does not include "sequential interposition"—infringes the Edwards patent.

For the foregoing reasons, it is hereby recommended that the defendant's motion for summary judgment on Count I of plaintiffs' Complaint be granted.

Respectfully submitted,

/s/ Edward A. Bobrick
EDWARD A. BOBRICK
United States Magistrate Judge

DATE: June 10, 1994